

REMARKS

Claims 1 - 23 are pending in the subject application. Claim 4 is amended to change "15%" to "5%" and Claim 6 is amended to change "20%" to "2%." Claims 10, 16 and 22 are amended to delete "aluminum, ammonia or potassium cations bonded thereto". New Claim 23 is added to recite an embodiment of the invention. Support for these amendments can be found, at least, on page 10 of the subject specification.

Claims 1-22 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-7, 11-14 and 17-20 are faulted as being indefinite regarding the use of the language "median particle size, by volume" and "a span value, by volume" because it is unclear as to what the volume is (in terms of amount)." Particle size distributions are readily and commonly defined by "volume" or by "number." These are based on the total volume or number of particles in the particle dispersion being defined. Thus, it is clear that the "volume" is a percentage based on the total volume.

Claims 2-5, 7, 12-14 and 18-20 stand rejected "because the span value is outside the scope of independent claim 1, 11 and 7." Applicants submit that the span value in claims 2-5, 7, 12-14, and 18-20 are within the span value of the independent claims and they are more narrow. For example, claim 2 has a span value of "greater than or equal to about 15 nanometers" and claim 1 has a span value of "greater than or equal to about 20 nanometers." Since a larger span value is broader in scope than a smaller span value (e.g., 20 as compared to 15), claims 2-5, 7, 12-14 and 18-20 are more narrow in scope than the claims they depend upon.

Claims 4 and 6 are amended to change a parameter thereof, and thus, obviate the rejections.

Claims 10, 16 and 22 are amended to delete "aluminum, ammonia or potassium cations bonded thereto", and thereby, render moot the rejection of said claims.

Claims 1-22 stand rejected under 35 U.S.C. §102(b) or 103(a) over WO 01/98201 or U.S. Patent No. 6,527,817 (Fang et al.). This rejection is respectfully traversed.

Fang et al. describe a polishing composition whereby the particle size distribution of the dispersion is defined in terms of number average. The definition of

a particle size distribution by number can be significantly different than the definition of a particle size distribution by volume. For example, the particle distribution span by number may be significantly different than the particle distribution span value by volume since measurement by number does not take into account the volume of the particle.

Inherent anticipation requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present in the prior art. *Trinteo Industries v. Top U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Additionally, facts asserted to be inherent in the prior art must be shown by evidence from the prior art. *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education and Research*, 304 F.3d 1221, USPQ2d 1292 (Fed. Cir. 2001). *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (criticizing the “hindsight syndrome wherein that which only the inventor taught is used against its teacher”).

The above-identified Fang et al. documents only teach a polishing dispersion with a particle size distribution defined by number. This will not necessarily result in the same particle size distribution defined by volume.

Accordingly, it is submitted that the subject matter of claims 1-22 are not inherently disclosed by the above-identified references, and Applicants respectfully request withdrawal of the §102 rejection.

As above-mentioned, the cited references do not even remotely suggest polishing dispersions having the related particle size distribution defined by volume, and do not even remotely suggest how the artisan would go about doing so. The examiner bears the burden of establishing a *prima facie* case of obviousness, *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995), *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992). Only if this burden is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant. *Rijckaert*, 9 F.3d at 1532, 28 USPQ2d at 1956. When the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The combination of elements in a manner that reconstructs the applicant's invention only with the benefit of hindsight is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *Diversitech Corp v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543,551 (Fed. Cir. 1985).

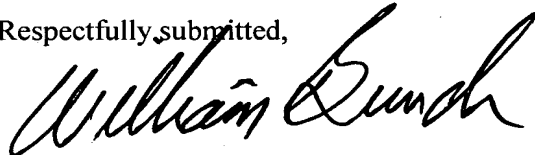
In the present case, Applicants submit the particle size distribution defined by number may be significantly different than that defined by volume, especially with regard to span value and large particle numbers or volumes. There is simply no reference to or description of particle size distribution by volume, and thus, no suggestion in Fang et al. of the polishing compositions recited in claims 1-23.

Therefore, Applicants submit that no *prima facie* case of obviousness has been set forth in the Office Action.

Accordingly, it is submitted that the subject matter of claims 1-23 are not rendered obvious by the above-mentioned references. Applicants respectfully request withdrawal of this rejection.

In view of the above remarks, Applicants earnestly solicit the withdrawal of the rejections set forth in the May 17, 2006, Office Action and notification to that effect in the form of a Notice of Allowability.

Respectfully submitted,



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